

## REMARKS

The present application has been reviewed in light of the non-final Office Action dated September 12, 2008. Claims 6, 7, 9 and 10 were pending. Claims 1-5 and 8 were previously cancelled and claims 11-13 were previously withdrawn from consideration. By this Amendment, claims 6, 7, 9 and 10 have been cancelled and new claims 14-21 have been added. Accordingly, claims 14-21 are now pending with claim 14 being in independent form.

### Rejection under 35 U.S.C. §112, first paragraph

Claim 7 was rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

By this Amendment, claim 7 has been cancelled. The rejection under 35 U.S.C. §112, first paragraph, is now moot and withdrawal of the rejection is respectfully requested.

### Rejections under 35 U.S.C. §§102 and 103

In the Office Action, claims 6, 7 and 9 were rejected under 35 U.S.C. §102(a) as being allegedly anticipated by U.S. Patent No. 6,352,503 to Matsui, et al., (hereinafter “Matsui”). Claim 10 was rejected under 35 U.S.C. §103(a) as being purportedly unpatentable over Matsui in view of U.S. Patent Application Publication No. 2003/0163029 to Sonnenschein, et al., (hereinafter “Sonnenschein”).

By this Amendment, claims 6, 7, 9 and 10 have been cancelled.

Withdrawal of the rejections under 35 U.S.C. §§102(a) and 103(a) is respectfully requested.

### New Claims

By this Amendment, new claims 14-21 have been added. Support for new claims 14-21 can be found in, for example, FIG. 27 and pages 75-81 of the specification as originally filed.

New independent claim 14 recites:

“An endoscope apparatus comprising:

an insertion portion having first and second channels arranged therein and terminating at first and second openings, respectively, at a distal portion of the insertion portion;

an observation optical system for capturing an observation image, which is arranged to the insertion portion;

a first treatment-tool oscillating base which guides, in a first direction and centering around a first rotating shaft, a first treatment-tool inserted via the first channel arranged to the insertion portion, a range of oscillation of the first treatment-tool by the first treatment-tool oscillating base being set so as to cause a distal end of the first treatment-tool to be selectively positioned inside or outside the observation image; and

a second treatment-tool oscillating base which guides, in a second direction which is different from the first direction and centering around a second rotating shaft, a second treatment-tool inserted via the second channel arranged in the insertion portion, the second rotating shaft being positioned closer to the distal portion side of the insertion portion than the first rotating shaft.”

Applicants respectfully submit that the cited references fail to disclose or suggest, individually or in any permissible combination, the limitation of (i) a first treatment-tool oscillating base which guides, in a first direction and centering around a first rotating shaft, a first treatment-tool inserted via the first channel arranged to the insertion portion, and (ii) a second treatment-tool oscillating base which guides, in a second direction which is different from the first direction and centering around a second rotating shaft, a second treatment-tool inserted via the second channel arranged in the insertion portion, the second rotating shaft being positioned closer to the distal portion side of the insertion portion than the first rotating shaft, as set forth in independent claim 14.

Claims 15-21 depend from and include each and every limitation set forth in independent claim 14. Accordingly, claims 15-21 are patentable over the cited references for at least the same reasons as claim 14.

As new independent claim 14 incorporates certain features of now-cancelled claim 7, Applicants will address below the Examiner's rejection of claim 7 on the grounds of anticipation by Matsui.

Applicants note that for a rejection on the ground of anticipation, each and every element as set forth in the claim must be expressly or inherently described in the single prior art document (see M.P.E.P. §2131).

On page 4 of the Office Action, the Examiner contends that unspecified structures that are "not labeled" in Matsui disclose a first treatment-tool oscillating base and a second treatment-tool oscillating base, as provided in now-cancelled claim 7 and new claim 14.

Applicants respectfully submit that there is no reasonable basis provided in the Office Action for the Examiner to assert that unspecified structures that are not labeled in Matsui discloses a first treatment-tool oscillating base and a second treatment-tool oscillating base, as set forth in now-cancelled claim 7 and new claim 14.

Further, in the Response to Arguments section on page 6 of the Office Action, the Examiner contends that the feature of "a first treatment-tool oscillating base which guides, in a first direction, a first treatment-tool inserted via the first channel arranged to the insertion portion, a range of oscillation of the first treatment-tool by the first treatment-tool oscillating base being set so as to cause a distal end of the first treatment-tool to be selectively positioned inside or outside of the observation image" as set forth in now-cancelled claim 7 and new claim 14 is a recitation of the intended use of the claimed invention and that if the prior art structure is capable of performing the intended use, then the prior art anticipates the claimed invention.

Still further, the Examiner contends that the prior art structure is capable of the alleged intended use only if it is modified. More specifically, the Examiner contends that the above

recited feature is inherent to Matsui because by modifying the length of the grasping forceps 145 in Matsui, the distal end of the grasping forceps 145 is capable of being guided outside the field of view.

Applicants note that to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. (see M.P.E.P. §2112, IV)

Therefore, the Examiner's proposed modification of grasping forceps 145 such that the same becomes "capable of being guided outside the field of view" fails to meet the standard for establishing inherency.

Stated another way, the feature of a first treatment-tool oscillating base which guides, in a first direction, a first treatment-tool inserted via the first channel arranged to the insertion portion, a range of oscillation of the first treatment-tool by the first treatment-tool oscillating base being set so as to cause a distal end of the first treatment-tool to be selectively positioned inside or outside the observation image, as set forth in now-cancelled claim 7 and new claim 14, is not expressly disclosed nor necessarily present in Matsui.

Applicants further submit that the recitation of a first treatment-tool oscillating base having a defined range of oscillation (i.e., set so as to cause a distal end of the first treatment-tool to be selectively positioned inside or outside of the observation image) in claim 7 is not a recitation of intended use. The Examiner's proposed modification of the Matsui apparatus itself establishes that structural differences exist between the claimed endoscope apparatus and the prior art.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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